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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,256	10/31/2003	Kazuo Okada	SHO-0054	9221

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EXAMINER	
SHAH, MILAP	
ART UNIT	**PAPER NUMBER**
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/697,256	OKADA, KAZUO	
	Examiner	Art Unit	
	Milap Shah	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 January 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 17, 2007 has been entered.

The Examiner acknowledges the amendment filed December 19, 2006, in which claims 13 & 16 were amended, no claims were canceled, and claim 17 was added. Therefore, claims 13-17 are currently pending.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10/644,955. Although the conflicting claims are not identical, they recite similar subject matter.

The Applicant argued the validity and properness of the double patenting rejection submitted in the previous prosecution initially in a non-final office action and maintained in the final office action. The Examiner submits the following table (next page) to more clearly support the non-statutory obviousness-type double patenting rejection. Claim 13 from 10/697,256 and Claim 1 from 10/644,955 are shown below, limitation for limitation, and it can be clearly seen that both applications are claiming the "same" subject matter. Claim 13 of 10/697,256 encompasses at least all of the limitations of claim 16.

In 10/644,955, the devices are under control of CPU, however, that is inherent in a gaming machine, thus, in 10/697,256 the various devices would naturally be under control of CPU or processing system within the gaming machine.

10/697,256 - Claim 13 A gaming machine comprising:	10/644,955 - Claim 1 A gaming device comprising:
variable display devices for variably displaying various symbols;	variable display device for varying a display of a plurality of symbols;
a lottery device for executing a lottery of a winning combination;	lottery device for executing a lottery for a prize pattern under control of the CPU;
a stop control device for performing stop control of variable display;	stop control device for controlling and stopping the variable display device under control of the CPU;
a stop control selection device for selecting a kind of control of the stop control device in reference to a result of the lottery;	stop control selection device for selecting a control type of the stop control device based on a result of the lottery under control of the CPU;
a shielding device for shielding approximately the whole area of the variable display devices, the shielding device being disposed in front of the variable display devices; and	shielding device for shielding a view of the variable display device under control of the CPU, the shielding device being disposed in front of the variable display device; and
a shielding control device for performing, in accordance with selection by the stop control device, switch control of the shielding device between a state enabling a player to visually recognize some of the symbols and another state disabling the player from visually recognizing some of the symbols; wherein the shielding control device performing, in accordance with a kind of stopping operation by the player, switch control between a first shielding state which is executing when the stopping operation matches the kind of the stop control device, and a second shielding state which is executing when the stopping operation does not match the kind of stop control device.	shielding control device for controlling the shielding device under control of the CPU to either state that a player can see the symbols or a state that the player cannot see the symbols so that a stopping order is indicated, by controlling the shielding device such that (i) a display area of a reel that is to be stopped is in the state that the player can see the symbols on the reel and (ii) display areas of the other reels that are not to be stopped are in the state that a player can not see the symbols on those reels.

The final limitation of the shielding control device in both claims are considered equivalent, such that based upon the stop control device (and essentially the lottery outcome) the shielding state is determined and the player is able to visually recognize or not recognize certain symbols. Since it appears that both applications encompass the same subject matter and portions of 10/697,256 are can be deduced from 10/644,955 and vise versa. And, in response to previous arguments, the similar subject matter is clearly within the claims.

Thus, in accordance MPEP 804, the Examiner has properly submitted both the differences between the inventions defined in the conflicting claims and reasons why a person of ordinary skill in the art would conclude the inventions defined in the two applications are obvious variants.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

This rejection has been updated and/or modified to accommodate updated claim language in both applications. Claims 1-4 of 10/644,955 are the claims submitted in the latest amendment filed 1/18/07 for that application, and claims 13-16 of 10/697,256 are the claims submitted in the latest amendment filed 12/19/06.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated Nishikawa (JP Publication No. 2000-300729). The English translation of abstract, detailed description, and claims was provided with the previous action.

Claims 13 & 16: Nishikawa discloses the same structure for a gaming machine comprising variable display devices (gaming reels or drums), a lottery device for executing lottery of a winning combination (random number generator to generate a random gaming outcome), a

stop control device, and a stop control selection device (i.e. a processor or gaming machine controller selectively stopping the reels at particular positions based on the determined game outcome as in almost any conventional gaming machine – see at least abstract, figures 3-5, and paragraphs 0002-009, 0013-0021 of English translation). Nishikawa also discloses a shielding control device being a liquid crystal display disposed in front of the variable display (figure 3) which changes between a state enabling a player to visually recognize some of the symbols and a state disabling the player from visually recognize some of the symbols (i.e. disable a player from viewing non-winning symbols via the liquid crystal display becoming opaque or colored in those positions, and enable a player to view the symbols associated with the winning pay line or winning combination so as to highlight the winning combination – see at least abstract, figures 3-5, and paragraphs 0002-0021 of English translation). Nishikawa discloses the shielding device is capable of shielding "approximately the whole area of the variable display devices" by disclosing that a player not receiving a winning combination in the lottery outcome produces a signal to the liquid crystal display to paint or make opaque all the symbols such that the player recognizes that he/she has not won a prize (paragraph 0016). Nishikawa's invention is quite capable of the following intended use. The "first shielding state" is considered the state in which a winning combination is displayed on the screen and thus, the control device, disables the viewing of non-winning symbols. The "second shielding state" is considered the state in which a non-winning combination is displayed on the screen and thus, the second shielding state is one in which no symbols are disabled from view since no winning symbols are present to highlight. It is to be noted that claims 13 & 16 are apparatus claims in which functional language is not given weight for determining patentability. It is submitted that the structure of the instant

claims and Nishikawa are equivalent, therefore, any specific intended use of the structural components are capable of being done by Nishikawa's gaming machine based on the equivalent structure. See MPEP 2114 directed to functional language in apparatus claims. An apparatus claim must be structurally distinguishable from the prior art.

Claim 14: As similarly discussed above, Nishikawa discloses the structure of the liquid crystal display capable of being an effect display, to display such arrangements as a bonus game, overtop the variable display after the second shielding state.

Claim 15: The liquid crystal display is considered an electronic shutter, as the display is a video display and "shutters" or blocks visibility of symbols.

Claim 17: Claim 17 incorporates much of the discussion of claims 13-16 with the addition of the "attraction display device" and the "attraction control device" for controlling the shielding device between a first and second state in combination with the attraction display device. As described above, Nishikawa's liquid crystal display is capable of display an attraction image, such that the attraction device and shielding device are a single component combined. Electronic shielding is considered the process of displaying an image on the translucent liquid crystal display that blocks a player from seeing any devices (i.e. the variable display devices) behind the translucent liquid crystal display. Therefore, this display is also capable of display attraction images simultaneously with images for blocking viewing of the variable devices. Additionally, the liquid crystal display device has a control section 27 and CPU 18 which drive the processes behind the shielding (paragraphs 0014-0016), thus, the "attraction control device" is equivalent to control section 27 and CPU 18 which operate or control the shielding states. Nishikawa's structurally equivalent gaming machine is capable of displaying attraction images at the same time that it makes all symbols on the variable display

device disabled from being visually recognized, for the purpose of displaying attraction or effect images for attracting players to the gaming machine. When the player is attracted to the gaming machine and plays, the attraction control device changes the state of the shielding device to enable visual recognition of the variable display devices and to allow game play. Therefore, Nishikawa is considered to anticipate claim 17 as well.

Response to Arguments

Applicant's arguments, with respect to the double patenting rejection, have been fully considered and were responded to in the advisory action. A clearer version of the double patenting rejection is submitted with this action. The rejection is updated and maintained.

Applicant's arguments, with respect to claims 13-17, filed December 19, 2006 have been fully considered but they are not persuasive.

The Applicant argues that Nishikawa discloses a slot machine only shielding some of the symbols and that the Applicant's claimed invention includes a shielding device for shielding not only some symbols but "approximately the whole area of the variable display devices". The Examiner respectfully disagrees. Nishikawa, at paragraph [0016] of the English translation discloses a condition in which no winning prize pattern is formed, the control section 27 of the liquid crystal panel 33 through CPU 18 sends a signal to "paint" (using the terminology of the English translation) all of the fields of the liquid crystal panel 33 (i.e. all symbol locations, thereby "approximately the whole area of the variable display device") for a fixed time amount, thus conveying to the player that he/she has not won a prize. A fixed time period thereafter, the liquid crystal panel 33 is made translucent for the purpose of confirming (visually by the player) that the gaming machine did not make a mistake and that the player has not won a prize. Thus, the liquid crystal panel is capable of

making the entire panel opaque, which disables visual recognition of the whole variable device area. Therefore, the Examiner maintains the rejection set for in the previous office action and submits that Nishikawa anticipates the amended limitation of "a shielding device for shielding approximately the whole area of the variable display devices, the shielding device being disposed in front of the variable display devices".

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.B.S.

Scott E. Jones

SCOTT JONES
PRIMARY EXAMINER